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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,404	07/29/2003	Noriyuki Suzuki	00862.023154	6374
5514 7590 12/28/2007 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
			EXAMINER CHERY, MARDOCHEE	
			ART UNIT 2188	PAPER NUMBER
			MAIL DATE 12/28/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary

Application No.

10/628,404

Applicant(s)

SUZUKI ET AL.

Examiner

Mardochee Chery

Art Unit

2188

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-7, 9-12 and 14-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-7, 9-12, 14-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 5, 2007 has been entered.

Response to Amendment

2. In response to the last Office Action, claims 1 and 12 have been amended. Claims 1, 4-7, 9-12, and 14-16 remain pending.

3. The rejection of claims 1, 4-7, 9-12, and 14-16 under 35 USC 112, first paragraph as for containing new matter is withdrawn in view of the remarks presented on page 7, filed on October 5, 2007.

Response to Arguments

4. Applicant's arguments filed October 5, 2007 have been fully considered but they are not persuasive.

- a. Applicant's representative argues on page 8 of the remarks that Yamamoto and Uchida do not disclose or suggest at least the feature of "judging,

by a storage unit, whether or not an operation which should be complete in the storage unit before the storage unit is ejected is complete”, recited in claims 1 and 12.

Examiner respectfully disagrees. Yamamoto clearly discloses “determining whether or not a recording operation is complete by using a cache storage that is controlled in such a manner that it is also held in the storage medium, constructed so that when the indication of ejection of the storage medium is given from a user to the memory device, a write processing for the storage medium is performed in the case where information to be recorded in the storage medium exists in the cache storage; Abstract; pars. 0017, 0018; a cache constituted in an HDD or DVD-RAM under the control of a Web cache program...and the control by the Web cache program is made so that the writing of the cache contents and necessary entries of the management table is completed before the DVD-RAM is removed; Abstract”.

b. Applicant's representative submits on page 10 of the remarks that “Yamamoto cache cannot reasonably be viewed as judging, by a storage unit, whether or not a recording operation in the storage unit is complete”.

However, it is not quite clear what applicant's representative intended to prove especially absent any explanation support such allegation. As shown above, Yamamoto clearly discloses “determining whether or not a

recording operation is complete using a cache storage held in the storage medium constructed so that when the indication of ejection of the storage medium is given from a user to the memory device, a write processing for the storage medium is performed in the case where information to be recorded in the storage medium exists in the cache; Abstract; pars. 0017, 0018".

- c. Applicant's representative further argues that Uchida does not disclose or suggest judging, by a storage unit, whether or not an operation which should be complete in the storage unit before the storage unit is ejected is complete".

Uchida discloses "a decision section 33 that compares the authentication information stored in the memory section 32 with input authentication information and decides whether or not these agree, an ejection instruction section 34 that outputs a disk ejection instruction to the mechanism control section 20 and if a disk ejection instruction is input from the input section 40 and the decision section 33 decides that the authentication information is in agreement; par. 0040".

- d. Thus, the rejection of claims 1, 4-7, 9-12, and 14-16 is maintained as reiterated below mutatis mutandis addressing the latest amendment.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 4-7, 9-12, and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto (2002/0032839) in view of Uchida (2004/0037174).

As per claim 1, Yamamoto discloses a storage unit which is detachable from an information processing apparatus, and has a storage medium for storing data from the information processing apparatus [Figs .2, 15; paragraph 12, lines 1-3, paragraphs 13 and 17-18] comprising: having ejecting means for ejecting the storage unit [Fig.15; par. 17]; output means for externally outputting an eject permission signal in accordance with input of the eject instruction [par.11]; judging means for judging whether or not an operation which should be complete in the storage unit before the storage unit is ejected is complete wherein said judging means is arranged inside the storage unit [Abstract; pars. 0017, 0018].

However, Yamamoto does not explicitly teach a controller for controlling storage of data into the storage medium; receiving means for receiving an eject instruction of ejecting the storage unit from the information apparatus; and output means for externally outputting an eject permission signal to the information processing apparatus

for ejecting the storage unit by said ejecting means if said judging means judges that the storage unit is in the ejectable as recited in the claim.

Uchida discloses a controller for controlling storage of data into the storage medium [Fig. 1; controller 20]; receiving means for receiving an eject instruction of ejecting the storage unit from the information apparatus [Fig. 1; eject instruction section 34]; and output means for externally outputting an eject permission signal to the information apparatus for ejecting the storage unit by said ejecting means if said judging means judges that the storage unit is in the ejectable state [Fig. 6; Abstract; pars. 8-11] to provide a disk drive device wherein removal of the disk drive by persons other than the authorized user can be positively prevented (par. 6).

Since the technology for implementing a storage unit with a controller, means for receiving an eject instruction, output means for outputting an eject permission signal was well known as evidenced by Uchida, an artisan would have been motivated to implement this feature in the system of Yamamoto to provide a disk drive device wherein removal of the disk drive by persons other than the authorized user can be positively prevented. Thus, it would have been obvious to one of ordinary skill in the art at the time of invention by Applicant to modify the system Yamamoto to include a storage unit with a controller, means for receiving an eject instruction, output means for outputting an eject permission signal since this would have provided a disk drive device wherein removal of the disk drive by persons other than the authorized user can be positively prevented (par. 6) as taught by Uchida.

As per claim 4, Yamamoto discloses output means uses an extra signal line [par.128].

As per claim 5, Yamamoto discloses input means receiving means receives an eject command as the eject instruction [par.11].

As per claim 6, Yamamoto discloses receiving means receives a status of an operation switch as the eject instruction via an extra signal line [par.128].

As per claim 7, Yamamoto discloses the receiving means further comprises switch receiving means for receiving a status of an operation switch, and notification means for notifying the information processing apparatus of an operation status of the operation switch on the basis of the status of the operation switch that is received by said switch receiving means [pars.124 and 127].

As per claim 9, Yamamoto discloses the operation switch is arranged in the storage unit [Fig.17].

As per claim 10, Yamamoto discloses providing means for providing a user interface [par. 8]; issuing means for issuing eject instruction to the storage unit in accordance with user operation to the user interface [par.8]; and eject means for

ejecting the storage unit on the basis of an eject permission signal which is output from the storage unit in accordance with the eject instruction [par. 11].

As per claim 11, Yamamoto discloses monitoring means for inquiring of the storage unit as to a status of an operation switch, and monitoring a status signal representing the status of the operation switch [pars. 124 and 127]; issuing means for issuing eject instruction to the storage unit in accordance with user operation to a user interface provided by software or the status signal [par. 127]; and eject means for ejecting the storage unit on the basis of an eject permission signal which is output from the storage unit in accordance with the eject instruction [par. 127].

As per claim 12, the rationale in the rejection of claim 1 is herein incorporated. Yamamoto further discloses an receiving step of receiving eject instruction to the storage unit in accordance with user operation to the user interface [par. 8]; and an eject step of causing the information processing apparatus to eject the storage unit on the basis of the eject permission signal [par.11].

Uchida further discloses an output step of causing the storage unit to output an eject permission signal to the information processing apparatus in accordance with the eject instruction after completion of shifting the storage unit to the ejectable state in the state shift step [Fig. 6].

As per claim 14, the rationale in the rejection of claim 1 is herein incorporated.

As per claim 15, Yamamoto discloses the apparatus further comprises an eject designation switch, and said transmission means transmits the eject instruction to the storage unit in accordance with operation on said eject designation switch [pars. 124 and 127].

As per claim 16, Yamamoto discloses the receiving means, after reception of the eject instruction, ignores a subsequent ejection instruction [0127].

Conclusion

7. When responding to the office action, Applicant is advised to clearly point out the patentable novelty that he or she thinks the claims present in view of the state of the art disclosed by references cited or the objections made. He or she must also show how the amendments avoid such references or objections. See 37 C.F.R. 1.111(c).

8. When responding to the Office action, Applicant is advised to clearly point out where support, with reference to page, line numbers, and figures, is found for any amendment made to the claims.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mardochee Chery whose telephone number is (571) 272-4246. The examiner can normally be reached on 8:30A-5:00P.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (571) 272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

December 21, 2007


HYUNG S. SOUGH
SUPERVISOR, PATENT EXAMINER
12/23/07


Mardochee Chery
Examiner
AU: 2188